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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,869	09/08/1999	MARY SMITH	83317/00004	9219
23387	7590	06/24/2004		
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			EXAMINER HENDERSON, MARK T	
			ART UNIT 3722	PAPER NUMBER

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/391,869

Applicant(s)

SMITH, MARY

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 26-36 is/are pending in the application.
- 4a) Of the above claim(s) 26-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 32, and 34-36 have been amended for further examination. Claims 22-25 have been canceled.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Michlin (5,141,252).

Michlin discloses in Fig. 1-3, a pocket insert capable of passing through a printer (Col. 3, lines 15-18) comprising a base sheet (16) with a thickness and a binding edge (folded area located at binding staple, 12) a pocket sheet (17) having the same thickness as that of the base sheet (Col. 2, lines 40-46), an adhesive or securing means between the base sheet and the pocket sheet to form a pocket with an opening (C) facing the binding edge; and wherein the pocket insert has a maximum thickness equal to the combined thickness of the single thickness (of the base sheet), the single sheet thickness (of the pocket sheet) and the adhesive.

In regards to the pocket insert thickness rendering the insert passable through a copier or printer in sequence with a sheet of paper, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making,

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the intended use must result in a manipulative difference as compared to the prior art. Therefore, the pocket insert of Michelin is capable of being passable through a printer in sequence with a sheet of paper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9, 11-13, 16-18, 32-34 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Wyant (5,823,573) in view of Dick.

Wyant discloses in Fig. 1, a book (not shown) having a pocket insert (see Attachment I) comprising: a one ply base sheet (10) made of paper material having a binding edge (14a, located on the left side of insert (5), near apertures (30)), wherein the base sheet (22) has a planar first surface (A1), a planar second surface (A2), a width (W2) defined by a first edge (14d) and second edge (14c), and a length (L1) defined by a third edge (14c) and fourth edge (14b) ; a one ply (however, this ply is not separate from the ply of the base sheet) pocket sheet (11) having a planar

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inner surface (11a), a planar outer surface (11b), a perimeter defined by a first attached edge section (11c, 11e, 11f) and a second free edge section (11d), wherein at least a portion (11c and 11e) of the attached edge section (11c, 11e, 11f) is bonded by any suitable means (Col. 2, lines 50 and 51) to the base sheet (10); and the free edge section (11d) being unattached to the base sheet to form a pocket opening (B); a third edge (11c) and a fourth edge section (11e) defining the pocket sheet length (L2); and wherein the pocket sheet has a width (W1) smaller than a width (W2) of the base sheet (22); and wherein the base sheet (10) and the pocket sheet (11) are arranged such that the pocket opening (B) faces and extends parallel to the binding or binding edge (14a); wherein the base sheet (22) and pocket sheet (11) are formed of a single section of paper material and folded along a fold line (15).

However, Wyant does not disclose: a pocket sheet perimeter defined by an attached edge section on the inner surface, wherein the section is attached through bonding, fusion or glueing to the first surface along a plurality of seams to form a continuous two ply seams defining a pocket with a closed end; and wherein the pocket has a width at least 60 percent of the width of the base sheet; wherein the pocket sheet and base sheet are separate sheets; wherein the base sheet and pocket sheet are adhered along respective edges; wherein the base sheet and pocket sheet are formed of a rectangular sheet having particular sizes; and a front and back cover, wherein the pocket inserts are bound between the covers, and further wherein the pocket retain supplemental media.

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Dick discloses in Fig. 1-4, a pocket insert at a particular location comprising a pocket sheet (4) perimeter defined by an attached edge section on the inner surface to a base sheet (1) by through any securing means along a plurality of seams (5) to form a two ply pocket with a closed end, wherein the pocket sheet and base sheet are separate sheets (seen in Fig. 2); and wherein a front and back cover are used to bind the inserts together, and wherein the pockets are used to retain supplemental media (8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wyant's pocket insert with a separate pocket sheet attached to a base sheet to form a pocket insert, wherein the sheets are attached by any securing means and wherein the inserts retain supplemental media and are bound between two covers as taught by Dick for the purpose of providing a more secured pocket.

In regards to **Claims 4, 16-18, 32, and 33**, it would have been an obvious matter of design choice to construct the pocket sheet and base in any desirable dimensions (length, width, and thickness), since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been obvious to construct the base and pocket sheet of any desirable size, since applicant has not disclosed the criticality of having the pocket and base sheets of a particular dimension, and invention would function equally as well with the pocket and base sheet at any dimension.

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Furthermore, it is well known that the types of methods of attaching (or securing by: gluing bonding or fusing) are considered an alternative (or suitable) securing method as evidenced by looking at Class 412-Bookbinding.

In regards to **Claims 1, 32 and 34** in which the pocket insert thickness renders the insert passable through a copier or printer in sequence with a sheet of paper, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the pocket insert of Michelin is capable of being passable through a printer in sequence with a sheet of paper.

4. Claims 10, 14, 15, 19-21, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyant in view of Dick and further in view of Ruebens (4,965,948).

Wyant as modified by Dick discloses a pocket insert comprising all the elements as claimed in Claims 1, 6, 7, 9, 13, 22, and 23, and as set forth above. However, Wyant and Dick do not disclose wherein the pocket sheet and base sheet are further adhered to one another along a strip, or a portion of the inner surface, so as to separate into two pockets.

Reubens discloses in Fig. 1, 3-6, a pocket sheet (22) that is adhered to a base sheet (20) along a strip or inner portion (26) which separates the pocket sheet into two pockets.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wyant and Dick's pocket insert to include an adhesive strip as taught by Reubens for the purpose of defining a plurality of pockets to hold numerous articles.

In regards to **Claim 36** in which the pocket insert thickness renders the insert passable through a copier or printer in sequence with a sheet of paper, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the pocket insert of Michelin is capable of being passable through a printer in sequence with a sheet of paper.

Response to Arguments

5. Applicant's arguments filed on March 23, 2004 have been fully considered but they are not persuasive.

In regards to applicant's arguments that the Michelin reference does not disclose whether the pocket insert thickness renders it passable through a printer or copier in sequence with a sheet of paper, the examiner submits that a recitation of the intended use of the claimed invention must

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result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the pocket insert of Michelin is capable of being passable through a printer in sequence with a sheet of paper. Furthermore, if the pocket sheet and base can be one ply sheet, wherein the pocket sheet is folded and attached to the base sheet to form the insert (as stated in Col. 2, lines 40-46), then the insert is capable of being passed through a printer as a whole.

In regards to Applicant's argument that the Dick reference does not disclose chemically bonded, fused, or glued construction for attaching the pocket insert to the base sheet, the examiner submits that Dick's recitation of "stitching or securing means" does indeed disclose all means of attaching or securing two items, since it is well known that the types of methods of attaching (or securing by: gluing bonding or fusing) are considered an alternative (or suitable) securing method as evidenced by looking at Class 412-Bookbinding.

In regards to applicant's arguments that modifying Wyant to incorporate features of Dick would render the Wyant article inoperative because a closed pocket would eliminate the tabs (12), which are essential to the Wyant insert, the examiner submits that the Wyant reference is indeed a closed pocket insert. The pocket is constructed in a closed state until an end user decides to open the tabs for filing purposes (Col. 1, lines 57-60). However, this does not necessarily mean that the end user will use the tabs.

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In regards to applicant's argument that the drawings on the teachings of Dick also would have the pocket opening not face the binding edge as claimed, the examiner submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Dick reference is only cited for disclosing a pocket constructed along a plurality of continuous seams. It is not cited for the location of the pocket sheet. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wyant's pocket insert with a separate pocket sheet attached to a base sheet to form a pocket insert, wherein the sheets are attached by any securing means and wherein the inserts retain supplemental media and are bound between two covers as taught by Dick for the purpose of providing a more secured pocket.

Therefore, the rejection have been maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

June 14, 2004



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